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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,784	10/20/2000	Arturo A. Rodriguez	A-6690	8546

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SCIENTIFIC-ATLANTA, INC.
INTELLECTUAL PROPERTY DEPARTMENT
5030 SUGARLOAF PARKWAY
LAWRENCEVILLE, GA 30044

EXAMINER

BELIVEAU, SCOTT E

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/693,784

Applicant(s)

RODRIGUEZ ET AL.

Examiner

Scott Beliveau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 83-86,96-99 and 109-113 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 83-86,96-99 and 109-113 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

However, the provisional application (60/214,978) upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112. In particular, the provisional application generally discloses that the user may select a video program, may receive a reminder when that program becomes available, and may manage a personal reminder list (Page 7 – Personal List Management; Page 5 – Full Motion Video). The provisional application, however, fails to disclose sufficient details as to the particular manner in which the user interacts with the interface. For example, the earlier filing fails to disclose the limitation of “responsive to associating the selected video presentation with the reminder list, providing the future release data of the selected rentable video presentation responsive to receiving a second viewer input selecting the selected rentable video presentation from the reminder list” or “while the release date is in the future provide the release date for rentability of the selected rentable video presentation responsive to receiving a second viewer input selecting the selected rentable video presentation from the reminder list” as recited in claims 83 and 96. Similarly, the earlier filing fails to provide adequate support for the limitation of “responsive to associating the selected video presentation with the second portion of the reminder list, providing a selectable option to select the first or the second portion of rentable video presentations from the reminder list and providing reminder information to the viewer after the selected rentable video presentation becomes available for rent via the STT, the reminder

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information being configured to remind the viewer that the selected rentable video presentation has become available for rent via the STT”.

2. With respect to applicant's claim for priority as a continuation-in-part to co-pending application No. 09/590,488, the earlier application discloses the overall system architecture of the utilized by the instant application (Figures 1-3) and illustrates similar GUI screen-shots. The claimed subject matter of the independent claims of the instant application pertaining to the adding of a selected media title to a “reminder” list does not appear to be supported in the parent application. Accordingly, elected claims 83-86 and 96-99 of the instant application shall be examined in view of the filing date or 19 October 2000.

Response to Arguments

3. Applicant's arguments with respect to newly presented claims 83-86, 96-99, and 110-113 have been considered but are moot in view of the new ground(s) of rejection.

With respect to applicant's arguments such that the McKissick et al. fails to particularly disclose a reminder list, the examiner respectfully disagrees. The instant application sets forth no special definition as to what is meant by a “reminder list” other than to set forth that it is associated with both programs which are currently available (ex. Now Showing) and those which are not currently available (ex. Coming Soon). A “notification” in McKissick is a special type of reminder which serves to remind or notify the user that programs previously not available have become available. A notification list as used by McKissick et al. is subsequently interpreted as being a portion of a “reminder list” in light of the specification. Both Ellis et al., McKissick et al., and Knudson et al. (also incorporated by reference) further

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set forth the usage of “reminders” in association with programs which are currently available/scheduled and may further display such as a “reminder list”. Both the notification reminders and the standard reminders can be displayed in a combined list such as that illustrated in Figure 12 of McKissick. Accordingly, it is the examiner’s opinion that the system of Ellis et al. comprises a logically construed “reminder list” locally stored at the user’s terminal comprised of two ordered portions corresponding to the notification reminders and the standard reminders.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
6. Claims 83-86, 96-99, and 109-113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (US Pub No. 2004/0117831).

In consideration of claims 83 and 96, the Ellis et al. reference discloses “television set-top terminal” [26] comprising “memory configured to store program code” [26] and a “processor” (not shown) so as to implement a method for facilitating providing reminders for upcoming presentations for rent (Para. [0098] – [0101]). As illustrated in connection with Figures 7 and 11, the system “provides a list of rentable video presentations by their respective titles” whereupon it “receives a first viewer input configured to select one of the video presentations from the list of video presentations . . . having a release date for rentability in the future” and “associates the selected rentable video presentation with a reminder list responsive to receiving the first user input” (Para. [0124], [0129], [0133], and [0134]). As disclosed, the program information screen [192] through which the user establishes a reminder notification “provides the future release date of the selected rentable video presentation”.

The Ellis et al. reference explicitly incorporates by reference the McKissick et al. reference (Para. [0134]) with respect to further details pertaining to the establishment of future available program or notification reminders. In particular, the McKissick et al. reference discloses “providing a list of rentable video presentation by their respective titles” whereupon the system “receives a first viewer input configured to select one of the rentable video presentations from the list of video presentations, the selected rentable video presentation having a release date for rentability in the future” (Page 24, Line 8 – Page 25, Line 12). As illustrated in Figure 7, the user is subsequently able to establish a variety of types of reminders including email reminders, message reminders, and notification reminders. “Responsive to associating the selectable video presentation with the reminder

list” and “responsive to receiving a second viewer input selecting the selected rentable video presentation from the reminder list” (Figure 4; Page 17, Lines 19-33; Page 20, Lines 23), the user is presented with the notification display screen [116] (Figure 7). It is the examiner’s opinion that the information displayed on the notification display screen [116] (Figure 7) of McKissick et al. includes the display elements of the program information screen [150] (Figure 7) of Ellis et al. in light of the Ellis et al. incorporation. As aforementioned, the program information screen [150] of Ellis et al. “provides the future release date of the selected rentable video presentation” as understood by the service provider (Ellis et al.: Para. [0134]). However, the McKissick et al. reference is silent as to the incorporation or exclusion of such information. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to particularly include information of the program information screen [150] of Ellis et al. onto the notification screen [116] of McKissick et al. for the purpose of advantageously allowing the user to view information related to the movie including “the future release date of the selected rentable video presentation”.

The system subsequently, “provides reminder information to the viewer after the rentability of the selected rentable video presentation becomes effective” wherein the “provided reminder information is different than a reminder corresponding to the start time of a video presentation” (McKissick et al.: Page 18, Line 1 – Page 19, Line 14; Page 20, Line 33 – Page 22, Line 7; Page 25, Line 29 – Page 26, Line 10; Page 27, Line 22 – Page 28, Line 20). For example, if the user selected either the email reminder option or the message option, such a reminder would be “different” than a notification reminder corresponding to

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the start time of the program. However, the claim as set forth need not be interpreted as such because it does not require that the reminders as claimed be for the same program as opposed to a video presentation. Accordingly, reminder information for the "Blair Witch Project" is clearly different than that provided for "a video presentation" such as "Saving Private Ryan" by virtue of each program being different.

Claims 84 and 97 is rejected wherein the "step of providing reminder information is performed responsive to a third viewer input requesting access to the reminder list" for the scenario wherein a "third input" is associated with the user modifying the established reminder is received. For example, if the user initially establishes a message reminder, responsive to a "first user input", and subsequently re-selects the program in association with the "second user input" then the user is provided with the notification screen [116] which is capable of receiving a "third user input" corresponding to modifying a previously set reminder. Accordingly, the reminder is "provided" in accordance with the user's preferences associated with the "third user input".

Claims 85 and 98 are rejected wherein subsequent to a program becoming available the program aforementioned selected program becomes an in-frame program which is displayed normally within the program guide or with a marker [312] thereby "providing reminder information . . . responsive to viewer input requesting access to the a list of video presentations currently available for rent" (McKissick et al.: Page 33, Lines 10-25).

Claim 86 is rejected in view of McKissick et al. wherein the "second viewer input [is] after a third viewer input requesting access to the reminder list" in conjunction with the scenario wherein a "third input" is associated with the user modifying the established

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reminder. For example, a user initially establishes a message reminder, responsive to a “first user input” and decides to modify the reminder. The user can subsequently submit a “third user input” [62] (Figure 2) in order to provide the reminder list (Figure 4) whereupon responsive to the “second user input” the user re-selects the program (ex. Blair Witch Project) whereupon the “future release date of the selected rentable video presentation” is provided (Figure 7). Subsequently, the method further comprises . . . the second viewer input being after a third viewer input requesting access to the reminder list”.

Claim 99 is rejected wherein Figure 12 of the McKissick et al. reference illustrates that the “step of providing reminder information is performed via a barker”.

In consideration of claims 109 and 110, in view of the combined references, the Ellis et al. reference stores or comprises a logically construed or super-set “reminder list” comprising both the notification reminders and current programming reminders or a “first portion comprising of currently rentable video presentations” and a “second portion comprising of rentable video presentations with future release dates” respectively in light of the incorporated McKissick et al. and Knudson et al. references (09/330,792) (Ellis et al.: Para. [0150]). The McKissick et al. reference, incorporated by reference, clearly sets forth the existence and storage of a notification or “reminder list . . . configured with a . . . second portion comprising of rentable video presentations with future release dates” wherein the “step of associating the selected rentable video presentation with the reminder list . . . comprises . . . associating the selected rentable video presentation with the second portion of the reminder list” corresponding to notification reminders, as previously set forth, and further suggests the existence of a “reminder list . . . with a first portion comprising of currently

rentable video presentations” (McKissick et al.: Page 16, Lines 11-30; Page 23, Line 16 – Page 24, Line 7). As disclosed such a “reminder list” comprising both portions can be presented together (Figure 12) or separately (Figures 4 and 22). The Knudson et al. reference provides further evidence as to the nature of reminders for current programs including the usage of a “reminder list . . . configured with a first portion comprising of currently rentable video presentations” (Figure 10).

In consideration of claim 111, the Ellis et al. reference discloses that the ability to access various hubs associated with current program reminders and future program reminders in association with a main menu [100] (Ellis et al.: Para. [0010] and [0114]). The McKissick et al. reference, incorporated by reference, discloses providing a “selectable option to select the . . . second portion of the rentable video presentations from the reminder list” (Figure 2). As aforementioned, the Ellis et al. reference incorporates by reference Knudson et al. (09/330,792) (Ellis et al.: Para. [0150]) which discloses providing a “selectable option to select the first . . . portion of the rentable video presentations from the reminder list” (Knudson et al.: Page 16, Line 17 – Page 17, Line 2; Page 24, Lines 14-25). Accordingly, taken in combination, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to provide “a selectable option to select the first or second portion of the rentable video presentations from the reminder list” in association with the main menu [100] of Ellis for the purpose of providing the user with a convenient means to select to view/manage either reminders associated with current programming or reminders associated with future programming which is not currently available.

In consideration of claim 112, the Ellis et al. reference sets forth a “method” implemented via a “television set-top terminal” [26]. As previously set forth the Ellis et al. reference sets forth the ability for a user to “configure a reminder list with a first portion for currently rentable video presentations” (ex. current or in-frame reminders) and a “second portion for rentable video presentations with future release dates” (ex. future or out-of-frame reminders). The method comprises “providing a list of rentable video presentations by their respective titles” (Ellis et al.: Figure 11; McKissick et al. Figure 14) and “receives a first viewer input configured to select one of the rentable video presentations from the list of video presentations, the selected rentable video presentation having a release date for rentability in the future” (McKissick et al.: Page 24, Line 8 – Page 25, Line 12). Subsequently, the “selected rentable video presentation [is associated] with the second portion of the reminder list” as illustrated in Figure 4.

“Responsive to associating the selected video presentation with the second portion of the reminder list”, the user may return to the main menu [100] of Ellis et al.. As previously set forth, the Ellis et al. reference discloses the ability to access various hubs associated with current program reminders and future program reminders in association with a main menu [100] (Ellis et al.: Para. [0010] and [0114]). Taken in combination with the teachings of Knudson et al. and McKissick et al., it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to provide “a selectable option to select the first or second portion of the rentable video presentations from the reminder list” in association with the main menu [100] of Ellis for the purpose of providing the user with a convenient means to select to view/manage either reminders associated with current

programming or reminders associated with future programming which is not currently available.

Finally, as previously discussed in conjunction with McKissick et al., the method, “responsive to associating the selected video presentation with the second portion of the reminder list”, “provides reminder information to the viewer after the selected rentable video presentation becomes available for rent via the STT”. The “reminder information [is] configured to remind the viewer that the selected rentable video presentation has become available for rent via the STT” (McKissick et al.: Figure 6).

In consideration of claim 113, as previously set forth, “responsive to receiving a second viewer input selecting the selected rentable video presentation from the second portion of the reminder list” (Figure 4; Page 17, Lines 19-33; Page 20, Lines 23), the user is presented with the notification display screen [116] (Figure 7). It is the examiner’s opinion that the information displayed on the notification display screen [116] (Figure 7) of McKissick et al. includes the display elements of the program information screen [150] (Figure 7) of Ellis et al. in light of the Ellis et al. incorporation. As aforementioned, the program information screen [150] of Ellis et al. “provides the future release date of the selected rentable video presentation” as understood by the service provider (Ellis et al.: Para. [0134]). However, the McKissick et al. reference is silent as to the incorporation or exclusion of such information. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to particularly include information of the program information screen [150] of Ellis et al. onto the notification screen [116] of McKissick et al. for the

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purpose of advantageously allowing the user to view information related to the movie including "the future release date of the selected rentable video presentation"

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Ellis et al. (US Pub No. 2002/0042913) reference discloses a system and method for building and managing user media lists.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343.

The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEB
July 27, 2005



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